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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,706

09/19/2005

Kuniharu Harada

3273-0214PUS1

7685

2292 7590 05/11/2009
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EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

05/11/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/549,706	Applicant(s) HARADA ET AL.	
	Examiner Rabon Sergent	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-13 and 15-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-7,9-13 and 15-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. An English language translation of WO 93/23490 has been obtained and has been provided with this action.
2. In response to the Office letter of January 9, 2009 holding applicants' amendment of September 30, 2008 non-responsive due to the shift of invention from a composition to methods of using, applicants have argued firstly that the position within the Office letter that the amendment of September 30, 2008 "set(s) forth only claims drawn to a non-elected invention" is "manifestly erroneous", because there has been no restriction requirement in the application and there has been no election in response to the non-existent restriction requirement, and applicants have argued secondly that the invention of current claims 1-7, 9-13, and 15-26 is dominated by the scope of the invention originally covered by such claims; accordingly, further action on the merits of all of the claims is respectfully solicited.

In response to the first argument, **the examiner's action is entirely consistent with the policy set forth within MPEP 821.03. It is noted that this section of the MPEP was clearly referenced within the Office letter.** Applicants "elected" the composition claims by original presentation; applicants did not originally set forth any method of using claims; accordingly and consistent with policy, the examiner indicated that the methods of using claims added by means of amendment were therefore subject to restriction, and the justification for restriction between the composition and methods of using was clearly set forth.

In response to the second argument, the issue of current claims 1-7, 9-13, and 15-26 being dominated by the scope of the invention originally covered by such claims appears to not be relevant in arguing the propriety of the restriction requirement. While it is not clear what is meant or intended by "dominated", it appears clear that applicants' argument sets forth no logical

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rationale consistent with established restriction rebuttal practice that establishes that the reason for restriction is improper. Accordingly, the position set forth within the Office letter of January 9, 2009 has been maintained, and claims 1-7, 9-13, and 15-26 are withdrawn from further consideration as being drawn to a non-elected invention.

3. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to component (A6), applicants have claimed that the polyamine has one or more amino groups. This language is confusing, since a polyamine, by definition, must have more than one amino group.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/23490 in view of Frisch, Jr. et al. ('295) and either Hansen et al. ('938) or Barron et al. ('844), each further in view of Stuart ('517).

WO 93/23490 discloses the production of storage stable contact adhesives based upon aqueous polyurethane dispersions, wherein the polyurethane is derived from the reaction of a polyisocyanate, satisfying applicants' component (A4); a polyol, satisfying applicants' component (A1); a tertiary amine containing isocyanate reactive component, satisfying applicants' component (A3); and an alkoxysilane containing isocyanate reactive component. See abstract. Furthermore, at page 8, lines 9+, the reference discloses the use of amine chain extenders, satisfying applicants' component (A6) and the use of potential anionic group containing isocyanate reactive compounds, such as dimethylolpropionic acid, satisfying applicants' component (A2).

6. While the primary reference fails to recite the use of basic compounds, corresponding to applicants' component (B), the position is taken that their incorporation would have been obvious to the skilled artisan in view of the disclosure pertaining to the potential anionic group containing reactant and the requirement to neutralize such groups to render them dispersible. It has long been known that in order to successfully employ potential ionic groups within polyurethanes to render them dispersible that the potential ionic group must be neutralized in order to render it ionic in nature. This position is supported by the teachings of Frisch, Jr. et al. at column 21, lines 31+. It is noted that Frisch, Jr. et al. disclose an analogous aqueous silylated polyurethane composition; therefore, its teachings are relevant to both the instant invention and the primary reference.

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7. Also, while the primary reference discloses an alkoxysilane containing isocyanate reactive component, the disclosed alkoxysilane component is not a secondary amino group containing alkoxysilane compound derived from the reaction of an alkoxysilane compound containing a primary amino group and a secondary amino group with (meth)acrylic esters. However, the reaction of primary amine-functional alkoxysilanes with (meth)acrylates to yield secondary amine functional alkoxysilanes suitable for use within silane functional polyurethanes having sealant and adhesive applications was known at the time of invention. This position is supported by the teachings of Hansen et al. and Barron et al. See column 2, lines 17-24 within Hansen et al. See abstract and column 3, lines 37-56 within Barron et al. Furthermore, though these references are silent with respect to the initial use of alkoxysilanes having both primary and secondary amine groups, the position is taken that the use of such alkoxysilanes to produce the aforementioned secondary amino group containing alkoxysilane compound would have been obvious in view of their disclosed use in the production of chemically analogous compounds derived from the reaction of primary amine-functional alkoxysilanes with unsaturated diesters for use in analogous silane functional polyurethane applications. This position is supported by the teachings of Stuart at column 6, line 45 through column 7, line 25 (especially column 7, lines 16-19) wherein primary amine group containing alkoxysilanes and primary amine group and secondary amine group containing alkoxysilanes are disclosed in equivalent fashion as being suitable for reaction with the unsaturated diesters of the reference. The respective reaction products are considered to be chemically analogous, because the same reaction of an amine group with an ethylenically unsaturated group occurs to produce them. In other words, given the chemical similarities between the secondary amino group containing alkoxysilanes derived from

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(meth)acrylates and those derived from unsaturated diesters, the position is taken that it would have been obvious to use any of the disclosed amino functional alkoxysilanes within Stuart to produce the secondary amino group containing alkoxysilane compounds of Hansen et al. or Barron et al. Furthermore, the position is taken that it would have been obvious to utilize the resulting secondary amino group containing alkoxysilane compounds as the alkoxysilane containing isocyanate reactive component of the primary reference. This position is logical in view of the fact that the primary reference and Hansen et al. and Barron et al. and Stuart are using the alkoxysilane functional compound for essentially the same purpose, and accordingly, one of ordinary skill in the art would have had a reasonable expectation of success in employing the resulting alkoxysilane reaction product in the composition of the primary reference.

8. Applicants remarks of September 30, 2008 and January 29, 2009 with respect to the prior art rejections have been considered; however, the remarks are insufficient to overcome the prior art rejection for the following reasons. Firstly, applicants' amendment necessitated a new ground of rejection that is not seen to be addressed by applicants' remarks. Secondly, applicants' remarks set forth within the response of September 30, 2008 concerning the properties of the urethane composition in no way establish anything unexpected in view of the teachings of the primary reference. The primary reference clearly teaches that the polyurethane composition functions as a contact adhesive; given this disclosure as well as the fact that the composition of the primary reference is so chemically similar to the composition of the instant claim, the position is taken that the skilled artisan would reasonably expect them to possess comparable properties, and there is insufficient evidence on the record to prove otherwise. Lastly, applicants' remarks of January 29, 2009 fail to appreciate the combined teachings of the

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references and the analogous art nature of the respective references. The argument that the rejection fails because the examiner has simply shown that each of the elements was, independently, known in the prior art is unconvincing, because such an argument fails to appreciate the relied upon teachings of the prior art and the relationship of these teachings to each other.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/
Primary Examiner, Art Unit 1796

R. Sergent
May 6, 2009